

REMARKS

STATUS OF THE CLAIMS

Claims 24-70 are pending as shown in the paper filed May 24, 2004. Claims 1-23 were subject to Restriction in a Restriction Requirement dated July 16, 2002. In a Response filed August 16, 2002, Applicants made a provisional election with traverse. Nonetheless, in an Office Action mailed on October 23, 2002, the Restriction Requirement was made FINAL. In response, Applicants submitted, on January 17, 2003, a Petition for Withdrawal of the Restriction Requirement and Amendment presenting new claims 24-70. Thus, claims 24-70 are pending. Also pending is the petition of the outstanding Restriction Requirement.

REQUEST TO WITHDRAW RESTRICTION REQUIREMENT

As noted above, there is currently a Petition for Withdrawal of a previous Restriction Requirement awaiting decision. Applicants submit that until this Petition is acted upon, it is improper to issue yet another Restriction Requirement. Indeed, mailing another Restriction Requirement causes confusion for both Applicants and the Patent Office. Accordingly, Applicants submit that the Restriction Requirement dated December 28, 2004 should be withdrawn until a decision on the Petition filed two years ago is issued.

RESTRICTION REQUIREMENT

With regard to the newly applied Restriction Requirement itself, Applicants note that it is improper for many of the same reasons the original, petitioned Restriction Requirement was improper.

In particular, where the original Restriction Requirement improperly restricted as between activation and repression domains, the outstanding Restriction Requirement improperly restricts as between engineered zinc finger proteins comprising one or more zinc finger proteins (Group A) and engineered zinc finger proteins in which it is specified that one or more of the zinc fingers comprise a mutated model zinc finger domain (Groups B to E). As is readily apparent, there is no factual or legal basis for distinguishing between "engineered" zinc finger domains and "mutated model" zinc finger domains because all of the zinc finger proteins are engineered, whether by selection, design or mutation. Simply put, mutated model zinc finger domains are a subset of engineered zinc finger domains. The Office acknowledges this

relationship by noting in the Restriction Requirement that, like Group A, Groups B-E, are drawn to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger protein. The nature of the particular fingers is matter of choice for the skilled artisan based on the disclosure and does not support a finding that Group A is distinct and independent from Groups B-E.

Applicants further note that all Groups share the same classification and sub classification (class 435, subclass 419). Thus, a search of the art for references relevant to one Group would necessarily and in all cases reveal art relevant to all the other Groups. There is, therefore, no serious burden imparted on the Examiner if the Groups are searched together. Such a search would save the Examiner time and effort.

Turning to the Restriction as between Groups B-E, Applicants submit that restriction between members of a Markush Group (in this case, between different zinc finger proteins as the source of the mutated zinc finger domain) is improper (see, MPEP § 803.02):

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.


Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

In the pending case, the allegedly distinct zinc finger proteins from which mutated zinc finger domains may be derived share a common utility (namely, DNA binding) and a substantial structural feature disclosed as being essential to that utility (namely, a zinc finger domain). *See, e.g.*, page 11, line 4 to page 12, line 2 of the specification. Accordingly, unity is present among Groups B to E and the restriction among these Groups is in error and should be withdrawn.

Solely to prevent further delays in the prosecution of this application, Applicants provisionally elect, with traverse, Group A. Applicants maintain their petition of the previous Restriction Requirement, and reserve the right to petition the present Restriction Requirement if it is made FINAL at any time during the pendency of this application.

Respectfully submitted,

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